

REMARKS

Claims 1-3, 6-8, 12, 14-19, 22-33, and 35-43 are currently pending in the present application, with claims 1, 16, and 29-30 being written in independent form. Claims 1, 6-8, 14-16, 18-19, 29-30, and 32-33 have been amended for clarity. Claims 4-5, 9-11, 13, 20-21, and 34 have been cancelled without prejudice or disclaimer, with claims 5, 9-10, 20-21, and 34 having been previously cancelled. The title has also been amended for formalistic reasons. Support for the amendments may also be found, for instance, in original claims 4, 11, and 13 as well in par. [0027]-[0034] of the published application (US 2006/0021548). Thus, no new matter has been introduced into the claims.

Claim Rejection under 35 U.S.C. § 112, Second Paragraph

Claims 1-4, 6-8, 11-19, 22-23, and 35-43 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. This rejection has been rendered moot by the present amendments. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

Claim Rejection under 35 U.S.C. § 102 (Ishihara)

Claims 1-4, 7-13, 15-18, 25, 29-32, and 34 stand rejected under 35 U.S.C. § 102(a) as being anticipated by WO 02/081131 (Ishihara). Applicants respectfully traverse this rejection for the reasons below.

To anticipate a claim, a reference must disclose each and every limitation of the claim.¹ Additionally, the reference must disclose all of the limitations “arranged as in the claim.”² Although limitations may be expressly or inherently disclosed, the Court of Appeals for the Federal Circuit has determined that inherency may not be established by probabilities or possibilities. “The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient.”³ Instead, the Examiner, if relying upon the theory of inherency, must provide a basis in fact and/or technical reasoning to reasonably support a determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art.⁴

Ishihara *fails* to disclose or suggest every limitation of the claims as amended. For instance, without conceding as to any of the Examiner’s assertions that are not specifically addressed herein, Applicants note that Ishihara *fails*, as a preliminary matter, to disclose or suggest a “surface charge mediating agent providing the conductive nanoparticles with a same surface charge and an **electrical double layer** formed of counter ions surrounding the conductive nanoparticles,” as recited by amended claims 1, 16, and 29-30. A review of the cited art reveals that Ishihara is completely silent in this regard.

For at least the reasons above, there can be no anticipation with regard to claims 1, 16, and 29-30. Consequently, there can be no anticipation with regard to claims 2-3, 7-8, 12, 15, claims 17-18, 25, and claims 31-32 at least by virtue of their

¹ *Lewmar Marine v. Bariant Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987).

² *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q 1264, 1274 (Fed. Cir. 1984).

³ *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

⁴ See *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); and *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

dependency from claims 1, 16, and 30, respectively. The rejections with regard to claims 4, 9-11, 13, and 34 have been rendered moot by the cancellation of those claims. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the above rejection.

Claim Rejection under 35 U.S.C. § 103 (JP '543)

Claims 1-4, 7-8, 11-13, 15-18, 25, and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 2002-216543 (JP '543). Applicants respectfully traverse this rejection for the reasons below.

JP '543 *fails* to disclose or suggest every limitation of the claims as amended. For instance, without conceding as to any of the Examiner's assertions that are not specifically addressed herein, Applicants note that JP '543 *fails*, as a preliminary matter, to disclose or suggest a "surface charge mediating agent providing the conductive nanoparticles with a same surface charge and an **electrical double layer** formed of counter ions surrounding the conductive nanoparticles," as recited by amended claims 1, 16, and 29-30. A review of the cited art reveals that JP '543 is completely silent in this regard.

For at least the reasons above, a *prima facie* case of obviousness cannot be established with regard to claims 1, 16, and 29. Consequently, a *prima facie* case of obviousness cannot be established with regard to claims 2-3, 7-8, 12, 15 and claims 17-18, 25, at least by virtue of their dependency from claims 1 and 16, respectively. The rejections with regard to claims 4, 11, and 13 have been rendered moot by the cancellation of those claims. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the above rejection.

Claim Rejections under 35 U.S.C. § 103 (Kawamoto + JP '543 or Ishihara)

Claims 1-4, 6-8, 11-19, 22-33, and 35-43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US 6,632,274 (Kawamoto) in view of JP '543 or Ishihara. Applicants respectfully traverse this rejection for the reasons below.

The above-discussed deficiencies with regard to JP '543 and Ishihara are also applicable to this rejection. Furthermore, the additional teachings of Kawamoto fail to remedy the deficiencies of JP '543 and Ishihara.

For at least the reasons above, a *prima facie* case of obviousness cannot be established with regard to claims 1, 16, and 29-30. Consequently, a *prima facie* case of obviousness cannot be established with regard to claims 2-3, 6-8, 12, 14-15, 37, claims 17-19, 22-28, 38-41, claim 42, and claims 31-33, 35-36, 43, at least by virtue of their dependency from claims 1, 16, 29, and 30, respectively. The rejections with regard to claims 4, 11, and 13 have been rendered moot by the cancellation of those claims. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the above rejection.

CONCLUSION

In view of the above, Applicants respectfully request the Examiner to allow all of the pending claims in the present application.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. §1.17; particularly, extension of time fees.

Respectfully submitted,

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By

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